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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,157	10/29/2003	Peggy K. Dear	21321.00	7145

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,157

Applicant(s)

DEAR, PEGGY K.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/29/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the metes and bounds of the claim can't be determined due to the phrase "and/or". The Markush terminology encompassed by the claim is not clear, in other words it is not clear what is selected from the group consisting of... (e.g. is it a sports activity theme, sports equipment or headgear?). For purposes of examination it is assumed that the applicants intend the sports theme to be directed to the elements disclosed in the Markush group.

Regarding claims 10-13, the claims appear to limit a pamphlet to being attached to a specific part of the stuffed figure, however the claims depend from claim 1 which utilizes alternative terminology with respect to the indicia format/attachment. Therefore if the examiner chooses the indicia being upon the chest of the stuffed figure (as allowed by claim 1) then claims 10-13 would not be relevant unless the examiner has chosen to find the pamphlet of claim 1. In other words it is unclear if applicants are attempting to limit the indicia to a pamphlet or merely limit a possible pamphlet

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attachment position. For the purpose of examination it is assumed that applicants are merely limiting a possible attachment means.

Regarding claims 14-16, it is not clear as to the structural features the applicants are attempting to claim. The claims are dependent from claim 1, which limits the structure to "a sports activity theme exhibited by sports equipment and headgear selected from the group consisting of baseball, football, tennis and majorette...", therefore it is not understood how the sports activities, as claimed relate to the activities of reading, praying and teaching (as required by claims 14-16). In other words, it is unclear what structure the applicants are attempting to claim, is it the Bible held by a stuffed figure in a baseball uniform? Is it a stuffed figure in a ministers uniform holding a football? Or some other combination?

The remainder of the claims are considered as best understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 in view of Lui '551. Hughey discloses a stuffed figure (col. 2, line 55) containing most of the elements of the claims including with reference to claim 1, a

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sports activity theme (figures 1-10) exhibited by head gear (figure 8, element 414b) and sports equipment (figure 8, 414a) where all of the above directed to tennis (as required by claims 1 and 5) and indicia on the chest (as required by claims 1 and 7) (figure 8, 416).

Hughey fails to explicitly teach that his stuffed figure is a rabbit in a sitting position, as required by claim 1. However, Liu teaches that it is known to provide a stuffed rabbit in a sitting position with a theme related accessory (figures 1-6). Therefore it would have been obvious to one having ordinary skill in the art, at the time of applicants invention to have manufactured the stuffed figure of Hughey in the form of a sitting rabbit for the purpose of amusement of the user. Furthermore the particular form of the stuffed figure and it's positioning is considered a pure design choice in that applicants disclose no advantage or critical need for such a form and positioning (see applicants specification page 9, lines 7-11).

Regarding claims 3-4 and 6, although Hughey fails to explicitly teach that his figure is drawn to specific sports such as, baseball, football, and majorette, the reference makes it clear that toy figures related to such themes are notoriously well known in the art (col. 1, lines 26-35). Therefore it would have been obvious to incorporate the themes of baseball, football and majorette with the device of Hughey for the purpose of added amusement to the user through a variety of motifs. Furthermore, the particular theme associated with the stuffed figure is considered a pure design choice in that applicants disclose no advantage or critical need for such a specified theme (see applicants specification page 11, lines 18+).

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Regarding claims 10-13, the claims are considered to be encompassed by Hughey since the use of the pamphlet is optional as claimed (i.e. claim 1 uses alternative language). It should be noted that Carraway '363 and Bailey '764 would be pertinent to the above claims if the pamphlet was explicitly claimed.

Regarding claims 14-16, the claims are considered to be encompassed by Hughey since there are no distinguishing structural features encompassed by the claims.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 and Lui '551, as stated above, and further in view of Carraway '363. Hughey, as modified by Lui, discloses all of the elements of the claims as stated above, but for indicia being a poem as required by claim 2. However, Carraway discloses a stuffed figure (10) which teaches that it is known to provide indicia with a stuffed figure in the form of a poem (col. 3, lines 30-39). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention to provide indicia in the form of a poem directed to a sport theme related to the stuffed figure for the purpose of introduction and description to the recipient. Furthermore, it would have been obvious to utilize indicia in poem format since it would only depend on the intended use of the assembly and the desired information to be displayed. Additionally, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the

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substrate may render the device more convenient by providing an individual with a specific type of message does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. a poem) and the substrate (e.g. stuffed figure) which is required for patentability.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughey et al '863 and Lui '551, as stated above, and further in view of Chen '311. Hughey, as modified by Lui, discloses all of the elements of the claims as stated above, but for indicia located on the soles of the stuffed figure. However, Chen discloses a stuffed figure which teaches that it is known to provide a stuffed figure with indicia related to a sports theme located on the chest and soles of the figure (figure 1). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention to provide a stuffed figure with indicia on it's soles for the purpose of interest and amusement of the user. Furthermore, it would have been obvious to place indicia on the soles of the stuffed animal since it would only depend on the intended use of the assembly and the desired information to be displayed. Additionally, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by

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providing an individual with indicia in a specific location does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. soles of the stuffed figure) which is required for patentability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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